

**REMARKS**

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

By the present amendments, claims 1, 2, 7 and 8 have been amended in response to issues raised in the Office Action. Page 1 of the specification and claim 40 were amended to correct typographical errors. Claims 1-4, 7-10 and 17-42 remain pending in this application.

In response to the issue raised in paragraph (3) of the Office Action, Applicants are submitting herewith an Information Disclosure Statement, including a copy of an International Search Report (ISR), a PTO-1449 form listing the documents cited in the ISR, and copies of the cited documents. Applicants request that an Examiner-initialed copy of the PTO-1449 form be returned to them.

In response to paragraph (4) of the Office Action, Applicants have amended several pages of the specification to capitalize the word "Decalin." The accepted generic terminology is given on page 10, line 1 and the penultimate line thereof.

The objection to the specification set forth in paragraph (5) of the Office Action has been obviated by correcting the spelling of the word "non-conjugated."

Claims 1-4, 7-9 and 17-42 were rejected under 35 U.S.C. §112, second paragraph, for reasons given in paragraph (7) of the Office Action. In response, claims 1, 2, 7 and 8

have been amended to replace the word "decalin" with its chemical name. Accordingly, the rejection has been obviated and withdrawal thereof is earnestly requested.

Claims 1-4, 7-10, 17-22, 27-32, 37 and 38 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,698,651 to Kawasaki et al. for reasons provided in paragraphs (9) and (10) of the Office Action. Reconsideration and withdrawal of this rejection are requested in view of the aforementioned amendments and for at least the following reasons.

The present claims have been amended to specify that the Tg of the random copolymer ranges from -30°C to +40°C. Support for this range may be found, for example, on page 11, lines 2-5 of the specification. Kawasaki et al. '651, on the other hand, discloses copolymers having a Tg "preferably not higher than -45°C, more preferably not higher than -50°C, particularly preferably not higher than -55°C." Note column 3, lines 60-61 and the claims of the reference. This distinction is significant.

As a result of this difference in the Tg of the random copolymer of the invention, one can obtain a wheel tire which exhibits improved braking performance due to an increase in the grasping action of the tire to the road surface and a savings in fuel costs due to the rolling friction of the tire during steady maneuvering. In contrast, the aim of the reference is directed toward "low-temperature flexibility of the rubber composition" as taught in Kawasaki et al. '651 in column 11, lines 42-52. The reference does not suggest the technical advantages of attainment of improvements of both the braking performance and the fuel cost aspect by the resulting tire according to the present invention. Thus, the cited

reference limits the Tg of the copolymer to below  $-45^{\circ}\text{C}$  and preferably below  $-55^{\circ}\text{C}$  to attain low-temperature flexibility whereas Applicants have determined that a Tg of  $-30^{\circ}\text{C}$  to  $+40^{\circ}\text{C}$  provides copolymers capable of manufacturing tires having improved braking performance and fuel economy.

For at least the above reasons, the §103(a) rejections based on Kawasaki et al. '651 should be reconsidered and withdrawn. Such action is earnestly requested.

The Office Action also refers in paragraph (11) thereof to U.S. Patent No. 5,922,823 to Sagane et al. Applicants note that the Tg of the copolymers disclosed in Sagane et al. '823 are not higher than  $-50^{\circ}\text{C}$  (column 9, lines 29-32). Again, as with Kawasaki et al. '651, the aim of Sagane et al. '823 is low temperature flexibility. There is no disclosure or suggestion therein which would provide motivation to prepare copolymers having a Tg within the range set forth in the present claims.

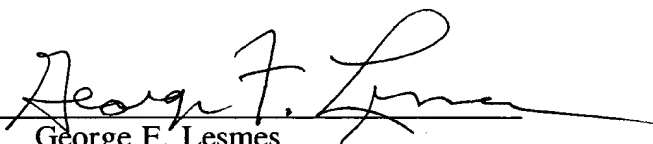
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By:

A handwritten signature in black ink, appearing to read "George F. Lesmes", written over a horizontal line.

George F. Lesmes

Registration No. 19,995

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620